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EXAMINER

VU, THONG H

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,719

Applicant(s)

MALIK, DALE W.

Examiner

Thong H. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Claims 1-19 are pending.

Response to Arguments

2. Applicant's arguments filed on 5/04/05 with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,4,6,7,9,15-17 are rejected under 35 U.S.C. § 102(e) as being anticipated by Birrell et al [Birrell, 6,009,462].

3. As per claim 1, Birrell discloses a method of storing an e-mail communication containing an attachment file received in an e-mail server [Birrell, a mail service system, Fig 1, col 4 lines 15-30; col 6 lines 15-47], comprising the steps of:

(a) searching a database of attachment files previously stored in the email server for a copy of the attachment file from the received e-mail communication [Birrell, mail database, col 1 lines 37-49; a query is composed one or more search terms, col 5 lines 54-62; col 7 lines 45-54; col 8 lines 7-56; col 9 lines 1-60; col 10 lines 6-20; col 11 lines 7-20]; and if a copy of the attachment file is located in the e-mail server [Birrell, discover an attached file, col 12 lines 59-67].

(b) removing the attachment file from the e-mail communication [Birrell, removing or deleting the attached data, col 7 lines 8-20; col 9 lines 22-37];

(c) creating a link from the e-mail communication to the previously stored attachment file in the database [Birrell, the attached and embedded components are replaced by hot-links, col 13 lines 1-7].

4. As per claim 2, Birrell discloses if a copy of the attachment file is not located in the e-mail server, (d) separating the attachment file from the e-mail communication and separately storing the attachment file in the database [Birrell, removing or deleting the attached data, col 7 lines 8-20; col 9 lines 22-37]; and (e) creating a link from the e-mail communication to the corresponding attachment file stored in the database [Birrell, the attached and embedded components are replaced by hot-links, col 13 lines 1-7].

5. As per claim 4, Birrell discloses the database of attachment files is searched by performing a checksum against the attachment file of the received e-mail communication as inherent feature of database searching.

6. As per claims 6,9 Birrell discloses (c) deleting the link from e-mail communication to the attachment file in response to a delete request; and (d) deleting the corresponding attachment file when there are no links remaining to the attachment file [Birrell, removing or deleting the attached data, col 7 lines 8-20; col 9 lines 22-37].

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7. Claim 7 contains the similar limitations set forth of claim 1. Therefore, claim 7 is rejected for the similar rationale set forth in claim 1.

8. As per claim 15, Birrell discloses an e-mail communications server comprising:

(a) an MTA server for receiving e-mail communications from an external network [Birrell, Web server 210, Fig 2];

(b) a mail store for storing e-mail communications received by the MTA server [Birrell, a mail server, col 6 lines 15-47];

(c) a POP server for downloading e-mail communications from the mail store to client computers through an internal network [Birrell, POP server 240, Fig 2];

(d) e-mail attachment file checking software for determining whether attachment files in received e-mail communications are duplicates of attachment files in the mail store, wherein the mail store removes duplicate attachment files from e-mail communications [Birrell, removing or deleting the attached data, col 7 lines 8-20; col 9 lines 22-37] and creates links from received e-mail communications to the corresponding attachment files in the mail store after the email attachment file checking software determines that the attachment files in received email communications are duplicates of attachment files in the mail store [Birrell, the attached and embedded components are replaced by hot-links, col 13 lines 1-7].

9. As per claim 16, Birrell discloses a database for storing the links from received e-mail communications to the attachment files [Birrell, mail database, col 1 lines 37-49].

10. As per claim 17, Birrell discloses a first attachment storage database for storing attachment files that are each associated with a single e-mail communication, and a second attachment storage database for storing attachment files that are each associated with a plurality of e-mail communications [Birrell, the attached and embedded components are replaced by hot-links, col 13 lines 1-7].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,5,8,10-14,18,19 are rejected under 35 U.S.C. § 103 as being unpatentable over Birrell [6,009,462] in view of Geiger et al [Geiger 6,073,142].

11. As per claim 3, Birrell discloses wherein the steps of searching the database [Birrell, mail database, col 1 lines 37-49; a query is composed one or more search terms, col 5 lines 54-62; col 7 lines 45-54; col 8 lines 7-56; col 9 lines 1-60; col 10 lines 6-20; col 11 lines 7-20], removing the attachment file from the e-mail communication [Birrell, removing or deleting the attached data, col 7 lines 8-20; col 9 lines 22-37]; and creating a link from the e-mail communication are only performed [Birrell, the attached and embedded components are replaced by hot-links, col 13 lines 1-7];

Birrell also teach a reasonable size of messages. However Birrell does not explicitly detail "detecting the size of the attachment file associated with the received email communication; or if the attachment file is greater than a predetermined size;"

It was well-known in the email art that a email message could be analyzed based on the POP rules and properties as taught by Geiger [Geiger, the gatekeeping Post office and business rules, abstract; monitor email message, col 3 lines 1-19; various properties, size attachment, col 13 lines 35-40]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique of monitoring the email message based on properties, size attachment as taught by Geiger into the Birrell's apparatus in order to utilize the POP server and attached data. Doing so would provide the ability to define the rules for handling of various type, size of data objects in the email via Internet.

12. As per claim 5, Birrell-Geiger disclose the database of attachment files is searched by comparing properties associated with the attachment files with corresponding properties associated with the attachment file of the received e-mail communication [Geiger, properties, col 13 lines 15-40].

13. As per claim 8, Birrell-Geiger disclose (e) if an attachment file is not a duplicate of a previously stored attachment file, storing the attachment file in the mail store and

storing a link in the mail store between the e-mail header information and the attachment file to the received e-mail communication [Geiger, header, Fig 14].

14. As per claim 10, Birrell-Geiger disclose e-mail messages in the e-mail communications are stored with the corresponding e-mail header information in the mail store [Geiger, header, Fig 14].

15. As per claim 11, Birrell-Geiger disclose the header information extracted from the attachment files includes a designation of file type [Geiger, type, size, col 13 lines 15-40].

16. As per claim 12, Birrell-Geiger disclose the step of comparing extracted attachment file header information is performed by searching the previously stored attachment files that are designated as the same file type as the attachment file to the received e mail communication [Geiger, header, Fig 14; type, size, col 13 lines 15-40].

17. As per claim 13, Birrell-Geiger disclose the header information extracted from the attachment files further includes at least one of: size, creation date, revision date, author, software type, version, and revision number as inherent feature of header.

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18. As per claim 14, Birrell-Geiger disclose comparing extracted attachment file header information is performed only when the size of the attachment file is greater than a predetermined size [Geiger, header, Fig 14; type, size, col 13 lines 15-40].

19. As per claim 18, Birrell-Geiger disclose the e-mail attachment file checking software only checks attachment files that are greater than a predetermined size [Geiger, header, Fig 14; type, size, col 13 lines 15-40].

20. As per claim 19, Birrell-Geiger disclose the e-mail attachment file checking software extracts properties associated with the attachment files in the received e-mail communications, and searches the mail store for attachment files having the same properties [Geiger, properties, col 13 lines 15-40].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Rupal Dharia*, can be reached at (571) 272-3880. The fax number for the organization where this application or proceeding is assigned is 703-872-9306

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
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